

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Jorg Ewert, <i>et al.</i>	§	Group Art Unit:	2617
		§		
Application No.	10/520,300	§	Examiner:	Cumming, William
		§		
Filed:	January 5, 2005	§	Confirmation No:	5072
		§		
Attorney Docket No: P16776-US1				
Customer No.: 27045				

For: Method for Enabling a Location Service Client to Contact a User of a Mobile Device

Via EFS-Web

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Commissioner for Patents
P.O. Box 1450
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CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage for First class or Express mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, or being facsimile transmitted to the USPTO at (571) 273-8300 or being transmitted via EFS-Web on the date indicated below.

Date: November 26, 2007

Name: Pamela C. Shultz

Signature: 

Petition under 37 C.F.R. §1.181, 1.182 to Withdraw a Holding of Abandonment

The Applicants hereby petition the Director to withdraw the Notice of Abandonment issued on September 27, 2007.

FACTS

- 1.) A Notice of Abandonment was issued by the Examiner on September 27, 2007, on the basis that Applicants had not filed a response to a Final Office Action mailed on February 23, 2007. (Exhibit A)
- 2.) Applicants never received a Final Office Action dated February 23, 2007.
- 3.) Upon receipt of the Notice of Abandonment, the Applicants checked PAIR and discovered that on March 2, 2007, the Final Office Action was "returned to USPTO as undelivered." (Exhibit B)

- 4.) Applicants printed a copy of the document associated with the PAIR entry for the undelivered mail, the first page of which is a copy of the envelope with no delivery address visible in the envelope window. (Exhibit C)
- 5.) The copy of the address sheet for the office action (Exhibit D), stamped with the date of return to the USPTO on March 2, 2007, does not reflect any creases from having been properly folded and placed in the envelope whereby the address would properly appear in the envelope address window.

USPTO PRACTICE

MPEP Section 707.13 states the practice of the USPTO with respect to returned Office Actions

707.13 Returned Office Action

Office actions are sometimes returned to the Office because the United States Postal Service has not been able to deliver them. Upon receipt of the returned Office action, the Technology Center (TC) technical support staff will check the application file record to ensure that the Office action was mailed to the correct correspondence address. If the Office action was not mailed to the correct correspondence address, it should be stamped "remailed" with the remailing date and mailed to the correct correspondence address. The period running against the application begins with the date of remailing. If the Office action was mailed to the correct correspondence address and it was addressed to an attorney or agent, a letter may be written to the inventor or assignee informing him or her of the returned action. The period running against the application begins with the date of remailing. *Ex parte Gourtoff*, 1924 C.D. 153, 329 O.G. 536 (Comm'r Pat. 1924).

If the Office is not finally successful in delivering the letter, it is placed, with the envelope, in the file wrapper. For an Image File Wrapper (IFW), a copy of the letter* and a copy of the envelope should be added to the IFW (see IFW Manual). If the period dating from the remailing elapses with no communication from applicant, the application is abandoned.

(emphasis added)

Furthermore, according to MPEP §711.03(c), ¶1.A.:

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's

representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. (emphasis added)

ARGUMENT

According to PAIR, the Final Office Action was returned to the USPTO as undelivered. Under USPTO practice, however, the correct correspondence address should be verified and the correspondence remailed. There is no record in PAIR of such remailing. Furthermore, the copy of the envelope in the Image File Wrapper (Exhibit C) does not show a delivery address visible in the envelope window, nor does the copy of the address sheet for the office action (Exhibit D), stamped with the date of return to the USPTO on March 2, 2007, reflect any creases from having been properly folded and placed in the envelope whereby the address would properly appear in the envelope address window. Therefore, it appears that the Final Office Action was not delivered to the Applicants because of a failure of the USPTO to properly mail, and remail, the correspondence to the Applicants.

Thus, the Applicants should not be required to file a Petition for Revival, and pay the fee therefore. To hold otherwise would place Applicants in the untenable situation of needing to simultaneously file a response to the outstanding Final Office Action when there is no rule as to whether the filing of that response would be accorded a filing date within two months of the mailing date of the Final Office Action, thus depriving the Applicants of the opportunity to receive an Advisory Action and tolling the period in which to file a Request for Continued Examination.

Under the showing specified in MPEP §711.03(c), ¶1.A., the undersigned attests that:

- 1.) the Final Office Action dated February 23, 2007, was not received by the practitioner; and,
- 2.) a search of the file jacket and docket records indicates that the Office communication was not received.

Also, submitted herewith (Exhibit E) is a copy of Applicant's docket record, where the non-received Final Office Action would have been entered had it been received and docketed, showing the proper docketing of prior office actions ("Official Action").

RELIEF REQUESTED

The Applicants respectfully request that the Notice of Abandonment be withdrawn and the Final Office Action dated February 23, 2007, be properly remailed.

* * *

DECLARATION

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Respectfully submitted,



Roger S. Burleigh
Registration No. 40,542

Date: November 26, 2007

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Appl. No. 10/520,300
Attorney Docket No. P16776-US1
EUS/J/P/07-1277

EXHIBIT A



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,300	01/05/2005	Jorg Ewert	P16776-US1	5072
27045 7590 09/27/2007 ERICSSON INC. 6300 LEGACY DRIVE M/S EVR 1-C-11 PLANO, TX 75024				
EXAMINER CUMMING, WILLIAM D				
ART UNIT		PAPER NUMBER		
2617				
MAIL DATE		DELIVERY MODE		
09/27/2007		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

RECEIVED
P16776-US1
OCT - 1 2007
RSB/PS
EUS LEGAL DEPT.

Notice of Abandonment	Application No.	Applicant(s)	
	10/520,300	EWERT ET AL.	
	Examiner	Art Unit	
	WILLIAM D. CUMMING	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

1. ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 23 February 2007.

(a) ☐ A reply was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply (including a total extension of time of _____ month(s)) which expired on _____.

(b) ☐ A proposed reply was received on _____, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection.

(A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).

(c) ☐ A reply was received on _____ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).

(d) ☒ No reply has been received.

2. ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).

(a) ☐ The issue fee and publication fee, if applicable, was received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).

(b) ☐ The submitted fee of \$_____ is insufficient. A balance of \$_____ is due.

The issue fee required by 37 CFR 1.18 is \$_____. The publication fee, if required by 37 CFR 1.18(d), is \$_____.

(c) ☐ The issue fee and publication fee, if applicable, has not been received.

3. ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).

(a) ☐ Proposed corrected drawings were received on _____ (with a Certificate of Mailing or Transmission dated _____), which is after the expiration of the period for reply.

(b) ☐ No corrected drawings have been received.

4. ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.

5. ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.

6. ☐ The decision by the Board of Patent Appeals and Interference rendered on _____ and because the period for seeking court review of the decision has expired and there are no allowed claims.

7. ☐ The reason(s) below:

/WILLIAM D CUMMING/
Primary Examiner
Art Unit: 2617

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

Appl. No. 10/520,300
Attorney Docket No. P16776-US1
EUS/J/P/07-1277

EXHIBIT B

This application is officially maintained in electronic form. To View: Click the desired Document Description. To Download and Print: Check the desired document(s) and click Start Download.

Available Documents

Mail Room Data	Document Code	Document Description	Document Category	Page Count
09-27-2007	ABN	Abandonment	PROSECUTION	2
03-02-2007	RETMAIL	Mail returned to USPTO as undelivered	PROSECUTION	12
02-23-2007	CTFR	Final Rejection	PROSECUTION	11
02-23-2007	SRFW	Search information including classification, databases and other search related notes	PROSECUTION	1
02-23-2007	FWCLM	Index of Claims	PROSECUTION	1
01-03-2007	A...	Amendment - After Non-Final Rejection	PROSECUTION	1
01-03-2007	CLM	Claims	PROSECUTION	4
01-03-2007	REM	Applicant Arguments/Remarks Made in an Amendment	PROSECUTION	3
01-03-2007	N417	Status Letter Mailed to Applicant	PROSECUTION	2
01-03-2007	TRTC	Transmittal to TC	PROSECUTION	1
01-03-2007	WFEE	Fee Worksheet (PTO-06)	PROSECUTION	1
10-03-2006	CTNF	Non-Final Rejection	PROSECUTION	8
10-03-2006	1449\	List of References cited by applicant and considered by examiner	PRIOR ART	1
10-03-2006	892	List of references cited by examiner	PRIOR ART	1
10-03-2006	SRFW	Search Information including classification, databases and other search related notes	PROSECUTION	1
10-03-2006	FWCLM	Index of Claims	PROSECUTION	1
09-27-2006	SRNT	Examiner's search strategy and results	PROSECUTION	6
05-26-2006	IDS	Information Disclosure Statement (IDS) Filed	PROSECUTION	2
05-26-2006	NPL	NPL Documents	PRIOR ART	76
05-26-2006	FOR	Foreign Reference	PRIOR ART	27
05-26-2006	N417	Status Letter Mailed to Applicant	PROSECUTION	2
09-26-2005	A.PE	Preliminary Amendment	PROSECUTION	2
09-26-2005	CLM	Claims	PROSECUTION	4
09-26-2005	REM	Applicant Arguments/Remarks Made in an Amendment	PROSECUTION	1
09-26-2005	WFEE	Fee Worksheet (PTO-06)	PROSECUTION	1
08-03-2005	M903	Notice of DO/EO Acceptance Mailed	PROSECUTION	2
01-05-2005	TRNA	Transmittal of New Application	PROSECUTION	2
01-05-2005	TRNA	Transmittal of New Application	PROSECUTION	2
01-05-2005	SPEC	Specification	PROSECUTION	31
01-05-2005	CLM	Claims	PROSECUTION	6
01-05-2005	ABST	Abstract	PROSECUTION	1
01-05-2005	DRW	Drawings-only black and white line drawings	PROSECUTION	5
01-05-2005	OATH	Oath or Declaration filed	PROSECUTION	4
01-05-2005	WFEE	Fee Worksheet (PTO-06)	PROSECUTION	1
01-05-2005	WFEE	Fee Worksheet (PTO-06)	PROSECUTION	1
01-05-2005	A.PE	Preliminary Amendment	PROSECUTION	1
01-05-2005	CLM	Claims	PROSECUTION	4
01-05-2005	REM	Applicant Arguments/Remarks Made in an Amendment	PROSECUTION	1
01-05-2005	IDS	Information Disclosure Statement (IDS) Filed	PROSECUTION	2
01-05-2005	BIB	Bibliographic Data Sheet	PROSECUTION	1
01-05-2005	WCLM	Claims Worksheet (PTO-2022)	PROSECUTION	1
01-05-2005	IMIS	Miscellaneous Internal Document	PROSECUTION	1
01-05-2005	371P	Documents submitted with 371 Applications	PROSECUTION	4

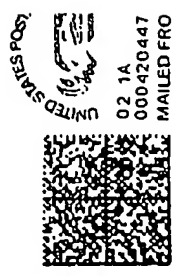
Appl. No. 10/520,300
Attorney Docket No. P16776-US1
EUS/J/P/07-1277

EXHIBIT C

Downloaded from
PAIR 10/25/2007

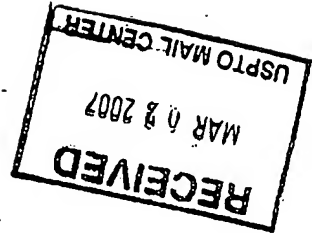
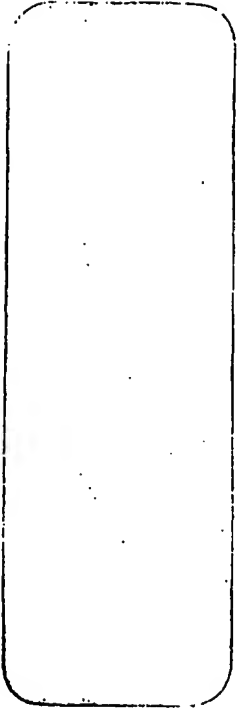
TC 2600 Bldg/Room KNOX

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Attorney Docket No. P16776-US1
EUS/JIP/07-1277

EXHIBIT D



UNITED STATES PATENT AND TRADEMARK OFFICE



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,300	01/05/2005	Jorg Ewert	P16776-US1	5072

27045 7590 02/23/2007
ERICSSON INC.
6300 LEGACY DRIVE
M/S EVR 1-C-11
PLANO, TX 75024

EXAMINER

CUMMING, WILLIAM D

ART UNIT PAPER NUMBER

2617

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/23/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Appl. No. 10/520,300
Attorney Docket No. P16776-US1
EUS/J/P/07-1277

EXHIBIT E

National CaseCountry - P16776 US1

Our Ref: P:6776 US1 Country: United States Status: Filed

Slogan: Framework direct/deferred location report

File: Memo: Party: Relation: Classification: Term: Log: ...

Term	Term Resp	Term Date	Original Term	Category	Term Kin	Seeded on	Seeded Term	Created on	Created by	Status
National Phase 2 Order	EUSJEVZ	2005-01-07	2005-01-07	Main		2005-01-07 01: EUSJENP20	2004-11-17	CEEDMMS		
National Phase 2 Order - Conf	EUSJEVZ	2005-01-24	2005-01-24	Main		2005-01-07 01: EUSJENP20	2004-11-17	CEEDMMS		
National Phase 2 - Deadline	EUSRRBH	2005-02-07	2005-02-07	Main	Office	2005-01-07 01: EUSJENP20	2004-11-17	CEEDMMS		
General Term	EEDMMS	2005-01-10	2005-01-10	Main		2004-12-22 03: EEDMDQ	2004-12-22	CEEDMMS		
xStatus Inquiry (EUS)	EUSJEVZ	2005-10-02	2005-06-05	Main	Comm	2005-08-09 01: EUSJE A054	2005-01-07	CEUSJEVZ		
xStatus Inquiry (EUS)	EUSPMSZ	2007-08-09	2007-08-09	Main	Comm	2006-10-10 03: EUSP A054	2005-08-09	CEUSJEVZ		
Official Action - Deadline	EUSRRBH	2007-01-03	2007-01-03	Main	Office	2007-01-04 09: EUSPN OA-DI	2006-10-10	CEUSPMSZ		
Official Action - Deadline	EEDTPF	2007-01-03	2007-01-03	Main	Office	2007-01-08 02: EEDN OA-DI	2006-10-11	EEDMMS		
Official Action - 1st Reminder	EEDMMS	2006-11-23	2006-11-23	Main		2006-12-12 01: EEDN OA1R	2006-10-11	EEDMMS		
Official Action - Due Date	EEDTPF	2006-12-03	2006-12-03	Main		2006-12-11 04: EEDN OA2R	2006-10-11	EEDMMS		
xStatus Inquiry (EUS)	EUSRRBH	2007-04-03	2007-04-03	Main	Comm	A054	2007-01-04	CEUSPMSZ		
General Term	EUSRRBH	2007-11-27	2007-10-27	Main		DDQ	2007-10-10	CEUSPMSZ		

☒ Display also seeded terms

New term: Process term:

Move term: Seeded / Recover term:

Delegate term:

Action or Allowance?